

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALBERT JAMES YOVICHIN, DANIEL RAY DOWNING,
and
JAMES ALFRED BENZING II

Appeal 2005-2314
Application 09/831,393
Technology Center: 1700

Decided: September 8, 2006

Before PAK, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1, 3-5, and 10, all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a method for providing a pre-cured innerliner for a pneumatic tire assembly. Claim 10 is illustrative:

10. A method for providing a pre-cured innerliner (50) for a pneumatic tire assembly (94), said pneumatic tire assembly being built on an associated tire building drum (48) and subsequently mounted into an associated shaping and vulcanizing mold (90), the method including providing calendering means (10) for forming a continuous strip of elastomeric material having a predetermined cross-sectional profile, the method comprising the steps of:

utilizing said calendering means to provide said continuous strip (12) of elastomeric material having a profiled surface (62) and a cross-sectional profile (66) including a center region (70) bounded by first and second lateral regions (72, 74), said center region having a maximum thickness T_1 at least twice a minimum thickness T_2 of said first lateral region;

providing a press with a pressing surface (82) which mates with said profiled surface; and,

utilizing said press to in-line cure a predetermined portion of said continuous strip of elastomeric material and preserve said cross-sectional profile by engaging said pressing surface with said predetermined portion, said predetermined portion having a length equal to or greater than a circumference of said associated tire building drum.

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The Examiner rejects the claims under 35 U.S.C. § 103(a). As evidence of unpatentability, the Examiner relies upon the following prior art references:

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|------------|--------------|---------------|
| Mirtain | US 4,065,338 | Dec. 27, 1977 |
| Bohm | US 4,089,360 | May 16, 1978 |
| Seiberling | US 4,166,883 | Sept. 4, 1979 |
| Uniroyal | GB 2,224,031 | Apr. 25, 1990 |

Specifically, the Examiner rejects claims 1, 3-5, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Seiberling or Uniroyal taken in view of Mirtain and/or Bohm.

We reverse.

OPINION

The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). This burden must be satisfied by the Examiner, otherwise, without more, an applicant is entitled to a patent. *Id.*

Appellants' claims are directed to a method for providing a pre-cured innerliner. All the claims require calendering and in-line curing a continuous profiled strip of elastomeric material to form the pre-cured innerliner. See, for instance, claim 10.

The Examiner finds that Seiberling and Uniroyal suggest providing an innerliner in pre-cured form to a tire assembly and that it was well known to provide innerliners with a thickened central region citing Mirtain and

Bohm. The Examiner further finds that Mirtain and Bohm also suggest a calendering means to form the desired thickened central region profile. With regard to using a press to perform the curing, the Examiner finds that the primary references to Seiberling and Uniroyal disclose using “usual methods of curing” (Seiberling) and curing by “conventional means” (Uniroyal). The Examiner then finds that “[t]he artisan would thus clearly have been taught or motivated to adopt the well known and conventional means to cure rubber sheets, it being *extremely well known per se in general* to use a curing press (i.e. with two adjacent press platens, etc.) to cure rubber sheets (it being noted that Appellants have not challenged this well known statement), use of such extremely well known and conventional means being obvious.” (Answer 6, emphasis added). As to the in-line curing aspect of the claimed method, the Examiner states that “since continuous materials are being formed (calendering being of course a continuous formation process) and must be cured, the artisan would have readily appreciated that there are really only two options - they can be either cured in-line or in two entirely separate processes/devices, the particular choice being well within the selection of the artisan based upon readily apparent concerns such as space and tooling considerations in a manufacturing plant.” (Answer 7-8).

The Examiner has found bits and pieces of the claimed process and has attempted to fill some gaps by taking notice of what is alleged as “extremely well known” in the prior art and attempted to fill further gaps by

modifying what is stated as “extremely well known.” There is simply not enough objective evidence in support of a case of *prima facie* obviousness on the present record.

A *prima facie* case of obviousness must be based upon the objective evidence of record. *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). It is true that an examiner can take notice of some facts beyond the record, but facts found in such a manner must be regarded with an eye toward narrowing the scope of any conclusions to be drawn therefrom. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970). In the present case, the Examiner makes a number of further determinations based upon what is called the extremely well known press means for curing rubber sheets. First, the Examiner further concludes that it would have been obvious to modify the well known press platen to give it a profile matching the calendered strip profile. Second, the Examiner reasons that it would have been obvious to use the curing press in-line with the calendered operation so that one would be curing a continuous strip. Given that there is no evidence with regard to the structure and conventional use of what the Examiner calls the “extremely well known” press for curing rubber sheets, there is little basis upon which to conclude that it would have been obvious to modify this press of unknown structure and use it to cure a continuous profiled strip to form a pre-cured innerliner. Nor is the context of use known for this “well known press for curing rubber sheets” and there is no basis upon which we can determine if there is a reason, suggestion, or

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motivation within the prior art to modify this press for use in forming the pre-cured profiled innerliner of the claims.

We conclude that the Examiner has failed to establish a *prima facie* case of obviousness.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1, 3-5, and 10 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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